

REMARKS

In the Office Action mailed March 11, 2005, the Examiner withdrew claims 23-26 from consideration as being directed to a non-elected invention. The Examiner rejected claims 1, 3-5, 21, and 22 under 35 U.S.C. § 112, second paragraph, as failing to set forth the subject matter which applicants regard as their invention; rejected claims 1, 3, 4, and 22 under 35 U.S.C. § 103(a) as unpatentable under U.S. Patent No. 5,684,965 to Pickering (hereinafter "Pickering") in view of Applicant's admitted prior art (hereinafter "AAPA"); and rejected claims 5 and 21 under 35 U.S.C. § 103(a) as unpatentable over Pickering in view of AAPA and further in view of U.S. Patent No. 5,465,206 to Hilt et al. (hereinafter "Hilt"). Applicants respectfully traverse the Examiner's restriction and rejections under both 35 U.S.C. § 112 and 103.

Regarding Claim Election/Restrictions

Applicants respectfully traverse the Examiner's restriction because claims 23-26 define other aspects of the present invention and thus are not directed to "an invention that is independent or distinct from the invention originally claimed." (Office Action at 2.) The Examiner alleged that "[c]laim 1 does not recite the use of a template, nor does it recite a BPP module. Conversely, claim 26 does not recite the feature of without identifying any billing entities. As such, these claims demark two subcombinations usable together. The method of claim 25 has separate utility such as a method of making an account transfer." (Office Action at 2). Applicants respectfully disagree.¹

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Although claim 1 does not directly recite the use of a template, its dependent claims, for example, claims 3 and 4, recite the use of a template. Thus, the invention recited by the claim set (i.e., independent claim 1 and its dependent claims) includes the use of a template. Furthermore, contrary to the Examiner's allegation, claim 1 does recite, for example, "executing a single instance of a bill presentment and payment application," which is a BPP (bill presentment and payment) module.

Further, independent claim 23 recites, for example, "receiving a billing request from the customer by a bill presentment and payment (BPP) module."² The "receiving a billing request from the customer by a bill presentment and payment (BPP) module" is another aspect of "receiving in a computer an electronic billing request from a customer without identifying any billing entities," as recited by claim 1 (emphasis added).

Moreover, while agreeing with the Examiner that claim 23 or 25 may have various utilities, Applicants point out that claim 23 clearly indicates that the method is used for "billing information associated with a plurality of billers." Similarly, claim 1 also indicates a "billing method associated with a plurality of billing entities."

Therefore, the Examiner's reasons for the restriction are not supported. Thus, Applicants' previously added claims 23-26 should not be withdrawn as directed to an invention that is independent or distinct from the invention originally claimed. Accordingly, Applicants respectfully request withdrawal of the restriction of claims 23-26.

² Although the Examiner lists claim 26 and claim 25 in two different instances, in view of the context, Applicants assume that the Examiner means independent claim 23 for the purpose of the restriction.

Regarding Claim Rejections under 35 U.S.C. § 112, second paragraph

Applicants respectfully traverse the Examiner's rejection of claims 1, 3-5, 21, and 22 under 35 U.S.C. § 112, second paragraph. Claim 1 recites, for example, "receiving in a computer an electronic billing request from a customer without identifying any billing entities." The Examiner alleged that "[e]vidence that claim 1 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in the specification on page 10, line 12, requires that billers be enrolled by the customer." (Office Action at 2). The Examiner appears to state that the specification contains teaching contrary to the claimed element of "receiving in a computer an electronic billing request from a customer without identifying any billing entities." Applicants respectfully disagree.

For example, paragraph 25 on page 10 includes "BPP module 220 displays billing information to a customer using a Web site associated with the consolidator's server and/or e-mail notifications. For example, a customer may log-in to a consolidator's Web site and view billing summary information for all billers with which the customer has enrolled in on-line billing." (emphasis added). Therefore, BPP module 220 receives a billing request (to display billing summary information to a customer) via customer's request for log-in or for viewing billing summary information for all billers.³ Nowhere does the specification indicate that a billing request includes identification of a specific biller.

³ A claim is allowable if the claim defines the patentable subject matter "with a reasonable degree of particularity and distinctness," "[s]ome latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire." M.P.E.P. § 2173.02.

The Examiner also alleged that "in Applicant's reply date 12/15/04, in that paper, applicant has stated 'if a customer is interested in participating in the program, the customer contacts the financial firm and provides the information regarding which company or utility bills should be included...'; this statement indicated that the invention is different from what is defined in the claim(s) because the claims state that the billing request is made without identifying billing entities." (Office Action at 2-3). Again, the Examiner appears to assert that Applicants' statements are contrary to the claimed invention. Applicants respectfully disagree.

Applicants noticed that the Examiner has misinterpreted an unfinished sentence. Page 10 of the Applicants' reply dated 12/15/04 includes

Instead, Pickering discloses a consolidated billing system having a customer enrolling process. 'If a customer is interested in participating in the program, the customer contacts the financial firm (usually by telephone) and provides information regarding which company or utility bills should be included, as well as personal information such as name, address and social security number.' Pickering, column 3, lines 58-63, emphasis added.

(Specification at 10.) Thus, the statement that the Examiner referred to is, in fact, from the prior art of record itself (i.e., Pickering), not from Applicants.

Therefore, the Examiner's rejection of claims 1, 3-5, 21, and 22 under 35 U.S.C. § 112, second paragraph, is not supported. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1, 3-5, 21, and 22 under 35 U.S.C. § 112, second paragraph.

Regarding Claim Rejections under 35 U.S.C. § 103

Applicants respectfully traverse the Examiner's rejection of claims 1, 3, 4, and 22 under 35 U.S.C. § 103(a) as unpatentable over Pickering in view of AAPA. In order to

establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143, emphasis added.

Claim 1 recites a combination including, for example, “executing a single instance of a bill presentment and payment application for: receiving in a computer an electronic billing request from a customer without identifying any billing entities.”

Pickering fails to teach or suggest at least this element recited by claim 1.

Moreover, the Examiner has conceded that “the [Pickering] invention is different from what is defined in the claim(s) because the claims state that the billing request is made without identifying billing entities.” (Office Action at 3).

AAPA fails to cure Pickering’s deficiencies. Applicants’ specification states that AAPA may “permit customers to view, store, and even pay bills using a Web browser, e-mail, or personal financial management software.” (Specification at 2). However, neither this discussion of prior art nor any other discussion of prior art in Applicants’ specification constitutes a teaching of “executing a single instance of a bill presentment and payment application for: receiving in a computer an electronic billing request from a customer without identifying any billing entities.”

Therefore, neither Pickering nor AAPA, taken alone or in any reasonable combination, teaches or suggests all claim elements recited in claim 1. As such, a *prima facie* case of obviousness has not been established by the Examiner.

Accordingly, Applicants respectfully request withdrawal of the rejection of claim 1 and timely allowance of this claim. Because claims 3, 4, and 22 depend from claim 1, claims 3, 4, and 22 are allowable for at least the same reasons stated above.

Applicants also request withdrawal of the rejection of claims 3, 4, and 22.

Applicants also respectfully traverse the Examiner's rejection of claims 5 and 21 under 35 U.S.C. § 103(a) as unpatentable over Pickering in view of AAPA and further in view of Hilt. Claims 5 and 21 depend from claim 1, either directly or indirectly. As explained above, Pickering and AAPA fail to teach or suggest at least "executing a single instance of a bill presentment and payment application for: receiving in a computer an electronic billing request from a customer without identifying any billing entities," as recited by claim 1.

Hilt fails to cure the deficiencies of both Pickering and AAPA. Hilt teaches an electronic bill pay system through which a consumer could pay a biller via the consumer's bank. See Hilt, abstract. In Hilt, after a consumer receives a bill directly from a biller, the consumer could authorize a remittance from the consumer's bank. To do that, the "consumer transmits to its bank a bill pay order indicating . . . the biller's biller identification number," and the bank then forwards the payment "to the biller's bank." Hilt, abstract, emphasis added. This is directly contrary to "executing a single instance of a bill presentment and payment application for: receiving in a computer an electronic billing request from a customer without identifying any billing entities," as recited by claim 1 (emphasis added).

Therefore, none of Pickering, AAPA, and Hilt, taken alone or in any reasonable combination, teaches or suggests all claim elements recited in claim 1. Claim 1 is thus

allowable over Pickering in view of AAPA and Hilt. Since claims 5 and 21 depend from claim 1, claims 5 and 21 are therefore also allowable for at least the same reasons stated above. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 5 and 21.

Conclusion


In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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